

REMARKS

Applicants already responded fully to the rejections given in the Final Action dated June 6, 2011, in the Response Under 37 CFR 1.116 filed September 6, 2011. Since the Examiner entered this Response in the Advisory Action dated September 19, 2011, applicants do not repeat the same responses given in the previous Response. Rather, in this Response applicants respond to the Examiner's arguments given in the Advisory Action.

Claims 1, 2, 4-8, 10, 13, 14 and 16 have been rejected under 35 USC 112, first paragraph, for lack of written description. Applicants respectfully traverse this rejection.

Claim 1 recites a heat sealable polypropylene resin laminate film including a heat sealable layer having a melting point of not more than 150°C as a surface layer, a substrate layer made of a crystalline polypropylene resin, and an intermediate layer disposed between the heat sealable layer and the substrate layer and comprising an α -olefin copolymer containing a cold xylene-soluble fraction in a proportion of not more than 3% by mass. Claim 1 also states that the substrate layer is not a heat sealable layer. The Examiner contends that the specification does not support the limitation that the substrate layer is not a heat sealable layer.

In the previous Response, applicants explained that the fact that the substrate layer can be melted for extrusion does not support the Examiner's contention that persons skilled in the art would consider the substrate layer to be a heat sealable layer.

In the Advisory Action, the Examiner responds as follows:

Applicant asserts [sic] on page 3 of the remarks dated 9/6/11 fail to provide any examples of implicit or explicit support for the recitation that the substrate layer cannot be heat sealed. The temperatures at which melt extrusion and heat sealing are performed are immaterial to the fact that a material which is melt extruded can also be heated to a temperature at which a heat seal is formed. Polymers which cannot be melted (i.e. polymers which are extensively crosslinked or vulcanized) do not form heat seals. All of the polymers disclosed by applicant can be melted.

This argument fails because it stands on an erroneous premise.

The Examiner assumes that persons skilled in the art would construe the term "a substrate that is not a heat sealable layer" to mean "a substrate layer that *cannot* be melted." However,

claim 1 does not say that the substrate cannot be melted. It simply says that the substrate is not a heat sealable layer. Meltability and heat sealability are not synonymous in this art; the Examiner cannot reasonably assert that they are. Furthermore, the term should not be construed in blank but must be construed in the context of the language of claim 1. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). The substrate and the heat sealable layer are both part of the claimed heat sealable laminate film. Claim 1 requires that among the three layers of the laminate film, one be a heat sealable layer and another be a substrate layer. Accordingly, persons skilled in the art would construe the term “a substrate that is not a heat sealable layer” to mean what it says, i.e., “a substrate that is not a heat sealable layer in a heat sealable laminate film.”

As explained in the Amendment filed April 1, 2011, the term “substrate layer” appears 40 times in applicants’ specification, excluding the claims. None of the passages describing the substrate layer discloses or suggests that the substrate layer is a heat sealable layer. On the other hand, the term “heat sealable layer” appears 59 times in the specification, excluding the claims. None of the passages describing the heat sealable layer discloses or suggests that the heat sealable layer is a substrate layer. This is consistent with the proper construction of the term explained above. Accordingly, persons skilled in the art would understand that applicants described a substrate that is not a heat sealable layer under the proper construction of this term. The Examiner’s argument fails since its premise is wrong.

Applicants also explained that the heat sealing method shown in FIG. 1 of this application clearly distinguishes a resin layer that is a heat sealable layer from a resin layer that is not a heat sealable layer. In the Advisory Action, the Examiner responds as follows:

Applicant’s assertion on page 4 of the remarks that one of ordinary skill would presume that the substrate layer could not be heat sealable because otherwise it would “stick to a heat plate used for heat sealing” is not persuasive given that those of ordinary skill in the art are well aware that different polymeric materials form heat seals at different temperatures. Applicant’s selection of a substrate layer which does not form a heat seal at the same temperature as the heat sealable layer is not evidence that the substrate layer is incapable of being heat sealed.

Again, the Examiner bases her argument on the premise that a substrate layer that is not a heat sealable layer is a substrate layer that “is incapable of being heat sealed.” This premise is wrong, as explained above.

Furthermore, the Examiner acknowledges “[a]pplicant's selection of a substrate layer which does not form a heat seal at the same temperature as the heat sealable layer.” In other words, the Examiner admits that the specification describes applicants' substrate layer as “a substrate layer which does not form a heat seal at the same temperature as the heat sealable layer.” This is in accordance with the proper construction of the claimed substrate layer, i.e., “a substrate that is not a heat sealable layer in a heat sealable laminate film.” Accordingly, the Examiner's statement above supports application's construction of the claimed substrate layer and thus the conclusion that the specification provides support for the limitation that the substrate layer is not a heat sealable layer.

The written description rejection of claims 1, 2, 4-8, 10, 13, 14 and 16 should be withdrawn because the specification describes the claimed substrate layer, as explained above.

Claims 1, 2, 4, 5, 7, 8, 10, 14 and 16 have been rejected under 35 USC 103(a) on U.S. Patent No. 4,726,999 (Kohyama) and “Crosslinking of Polypropylene,” by Ivan Chodák, in Polypropylene – An A-Z Reference, pp 128-134, Kluwer Publishers (Chodák). Applicants respectfully traverse this rejection.

The Examiner admits that Kohyama does not disclose or suggest the claimed substrate layer, which the Examiner refers to as “an additional substrate layer.” However, the Examiner contends that persons of ordinary skill in the art would have added Chodák's layer to Kohyama's laminate film for improving the strength of the laminate film. In the previous Response, applicants explained that persons of ordinary skill in the art would have had no reason to add “an additional substrate layer” to Kohyama's laminate film because Kohyama's laminate film already has “superiority in mechanical properties” as the Examiner pointed out.

In the Advisory Action, the Examiner responds as follows:

Applicant's assertion on page 5 of the remarks that one of ordinary skill in the art would not seek to improve the strength of the laminate of Kohyama because it was already recited to be superior is not found persuasive. The Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. The motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.* at 1366 80 USPQ2d at 1649 (Fed. Cir. 2006). “[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the improvement is technology-independent and the combination of references results in a product or

Applicants note that the passage from *DyStar Textilfarbe* as quoted by the Examiner ends abruptly in midsentence. Applicants respectfully disagree with the Examiner.

Applicants agree that “[t]he motivation to combine may be implicit and may be found in the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.” However, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Thus, the Examiner must provide an articulated reasoning to support the conclusion of obviousness. The Examiner has failed to do so.

In the Final Action, the Examiner contended that the reason to add Chodák's additional substrate to Kohyama's resin laminate film is to improve the strength of Kohyama's laminate film. Applicants rebutted this argument by pointing out that Kohyama's laminate film already has “superiority in mechanical properties” as the Examiner admits. In the Advisory Action, the Examiner failed to provide any other reason to support her conclusion of obviousness. Accordingly, the Examiner has failed to make out a *prima facie* case of obviousness of the invention of claim 1.

The rejection of claims 1, 2, 4, 5, 7, 8, 10, 14 and 16 under 35 USC 103(a) on Kohyama and Chodák should be withdrawn because Kohyama and Chodák together do not teach or suggest the claimed invention as a whole.

The remaining obviousness rejection relies on Kohyama and Chodák and thus should be withdrawn as well because Kohyama and Chodák do not provide the teachings for which they are cited.


In light of the above, a Notice of Allowance is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 358362011500.

Respectfully submitted,

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